



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/733,646

12/12/2003

Reinhard Ebner

PF403D2

9581

22195

7590

07/07/2006

HUMAN GENOME SCIENCES INC.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

EXAMINER

HADDAD, MAHER M

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/733,646	EBNER ET AL.	
	Examiner	Art Unit	
	Mahe M. Haddad	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/8/06.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-48 is/are pending in the application.
- 4a) Of the above claim(s) 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-35,37 and 44-48 is/are allowed.
- 6) ☒ Claim(s) 36 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/12/03 & 8/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1644

DETAILED ACTION

1. The Art Unit location and the examiner of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Maher Haddad, Art Unit 1644, Technology Center 1600.
2. Claims 26-48 are pending.
3. Applicant's election with traverse of Group III, claim 19 (now claims 26-37 and 39-48) drawn to an isolated antibody or fragment thereof that specifically binds to an Ependymin polypeptide of SEQ ID NO: 2 filed on 5/8/06, is acknowledged.

Applicant's traversal is on the grounds that a search of the claims of any of the groups would also provide useful information for the claims of the other groups. Applicant submits that in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein, antibodies that bind to that protein, and methods for making and using the protein. Applicant contends that since the searches for proteins, nucleic acids encoding such proteins, antibodies that bind to such proteins, and methods for making and using such proteins commonly overlap, combined search and examination of such compositions would not entail a serious burden. This is not found persuasive because nucleic acids, polypeptides and antibodies are distinct because their structures, physiochemical properties are different and are therefore capable of separate manufacture, use and sale. Said products are distinct and independent, and searches of all groups would place an undue burden upon the examiner due to the distinct and divergent subject matter of each Group. Further, a prior art search also requires a literature search. It is an undue burden for the examiner to search more than one invention.

The requirement is still deemed proper and is therefore made FINAL.

4. Claim 38 is withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.
5. Claims 26-37 and 39-48 are under examination as they read on an isolated antibody or fragment thereof that specifically binds to an Ependymin polypeptide of SEQ ID NO: 2.
6. The specification on page 1 should be amended to reflect the status of parent application No. 10/187,904.
7. The U.S. Patents 6,683,161 and 6,489,138 cited on the PTO FORM 892 is issued from the parental application serial Nos. 10/187,904 and 09/229,583, respectively.

Art Unit: 1644

8. Applicant's IDS, filed 12/12/03 and 8/24/05, is acknowledged.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 36 and 39-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

The phrase "an isolated cell that produces the antibody or fragment thereof" claimed in claim 36"; the phrase "at least 30 contiguous amino acid residues of SEQ ID NO: 2 in length" claimed in claim 39 (a and c) and the phrase "at least 50 contiguous amino acid residues of SEQ ID NO: 2 in length" claimed in claim 39(b and d) represent a departure from the specification and the claims as originally filed.

Applicant's amendment filed 5/8/06 points to the specification at page 51, paragraph 141 to page 53, paragraph 147 for support for the newly added limitations "an isolated cell that produces the antibody or fragment thereof" as claimed in claim 36"; "at least 30 contiguous amino acid residues of SEQ ID NO: 2 in length" as claimed in claim 39 (a and c) and "at least 50 contiguous amino acid residues of SEQ ID NO: 2 in length" as claimed in claim 39(b and d). However, the specification does not provide a clear support for such limitations. It is noted that claim 36 claims a genus of cells that produce the claimed antibody including recombinant cells that produce the antibody, however, the specification only discloses splenocytes and hybridoma cells. Further, the Examiner could not find the limitation at least 30/50 contiguous amino acids residues of SEQ ID NO: 2, the specification (paragraph 17) discloses that the epitope-bearing portion of a Ependymin polypeptide is preferably at least about 30 amino acids to about 50 amino acids. The "at least 30/50 contiguous amino acid" reads on a fragment that is more than 50 amino acids. The instant claims now recite limitations which were not clearly disclosed in the specification and recited in the claims as originally filed.

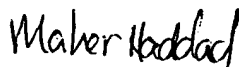
11. Claims 26-35, 37 and 44-48 are allowable.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (571) 272-0845. The examiner can normally be reached Monday through Friday from 7:30 am to 4:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 26, 2006



Maher Haddad, Ph.D.

Patent Examiner

Technology Center 1600